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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/633,143

07/31/2003

Thomas F. Doyle

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EXAMINER

HAYLES, ASHFORD S

ART UNIT

PAPER NUMBER

3687

NOTIFICATION DATE

DELIVERY MODE

06/22/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

us-docketing@qualcomm.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/633,143	<b>Applicant(s)</b> DOYLE ET AL.	
	<b>Examiner</b> ASHFORD HAYLES	<b>Art Unit</b> 3687	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-10,13-18 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-10,13-18 and 21-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 11, 2010 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**3. Claim 1-3, 6-7, 9-10, 13, 16, 18, 21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prange (2005/0086138) in view of Wolfe et al. (PG PUB. 2003/0083913).**

**As per Claims 1 and 18**, Prange discloses an apparatus for providing separable billing services (Figure 1, Billing Calculation Center 8), comprising:

storing an identifier, the identifier identifying the digital processing device connected to a data network, the identifier further assigned a communication type (pg.1, ¶ [0011] discusses standard information: identity of the subscriber identity module in the mobile radio terminal 3, duration of the call, tariff, roaming charge, etc.,

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details of the service-related or private nature of the current or most recently made call are also stored in a list billing record for this subscriber 1 or for his subscriber identity module, in the billing calculation server 8); and

receiving a data packet, the data packet comprising an address, the processor for comparing the address to the identifier and for adjusting an account associated with the communication type if the address matches the identifier (pg.1, ¶ [0011] A message representing the service-related or private nature of the current or most recently made call can be sent by the mobile radio terminal 3 as a short message SMS, MMS, etc., USSD or in another manner to an address of the mobile radio network 5,6, from where it is forwarded to a billing calculation server 8 of the mobile radio network to enable the monthly charges to be calculated).

Prange fails to disclose a memory operatively connectable to the MCT, a processor operatively connectable to the MCT, a mobile communications terminal (MCT) operatively connectable with at least one digital processing device across a satellite communications system and at least one of a destination address and a source address.

Wolfe et al. teaches a memory operatively connectable to the MCT (Figure 2, Memory 206), a processor operatively connectable to the MCT (Figure 2, Processor 204) and a mobile communications terminal (MCT) operatively connectable with at least one digital processing device across a satellite communications system (pg.3, ¶ [0020] discusses satellite communication system 100 comprises a Network Management Facility (NMF) 104 otherwise known as a central facility or hub, a communication

satellite 106, at least one wireless transceiver, or mobile communication terminal (MCT), located within, for example, a vehicle 108, and at least one dispatch center, for example, dispatch center 102) and at least one of a destination address and a source address (pg.4, ¶ [0035] discusses messages received from a vehicle or a WCD comprise information which allows NMF 104 to identify the intended recipient of the message, thus determining a destination address).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the memory and processor of an MCT as well as satellite communication as in Wolfe et al. in the system executing the method of Prange with the motivation of offering virtual capacity to a service provider (pg.2, ¶ [0013]) as taught by Wolfe et al. over that of Prange.

**As per Claims 2, 13 and 21** Prange discloses the apparatus of Claim 1, further comprising an interface for routing said data packet to a destination associated with the address (Figure 1, depicts Short Message Center 7 interfaced with Billing Calculation 8).

**As per Claim 3** Prange discloses the apparatus of Claim 1, wherein the communication type comprises a business-type communication (pg.1, ¶ [0011] discusses service related call).

**As per Claims 6, 16 and 24** the apparatus of Claim 1, wherein the processor further comprising a second account, the second account associated with a second type of communication, if the address does not match the identifier (pg.1-2, ¶ [0011] discloses charge information is split in accordance with the information stored on the

service-related or private nature and produces two part-invoices for service-related and private calls for the invoice for the mobile radio subscriber 1. In this case the basic subscription charge can also for example be split pro-rata or equally).

**As per Claim 7** the apparatus of Claim 6, wherein the second type of communication comprises a personal-type communication (pg.1, ¶ [0011] discloses private nature calls).

The Examiner notes for examination purposes, the Examiner will take the broadest reasonable interpretation of the above underlined portion of the claims. Since the "if" statement is conditional and not necessarily performed, once the positively recited steps in the claims are satisfied, the method as a whole is satisfied -- regardless of whether or not other steps are conditionally invocable under certain other hypothetical scenarios.

**As per Claim 10**, Prange discloses an apparatus for providing separable billing services (Figure 1, Billing Calculation Center 8), comprising:

receiving a data packet, the data packet comprising a first address identifying a digital processing device connected to a data network (pg.1, ¶ [0011] A message representing the service-related or private nature of the current or most recently made call can be sent by the mobile radio terminal 3 as a short message SMS, MMS, etc., USSD or in another manner to an address (for example a short message center 7) of the mobile radio network 5,6, from where it is forwarded to a billing calculation server 8 of the mobile radio network to enable the monthly charges to be calculated);

comparing the address to an identifier stored in a memory, the identifier identifying one of such digital processing devices, the identifier further assigned a communication type comprising either a business-type communication or a personal-type communication (pg.1, ¶ [0011] discusses standard information: identity of the subscriber identity module in the mobile radio terminal 3, duration of the call, tariff, roaming charge, etc., details of the service-related or private nature of the current or most recently made call are also stored in a list billing record for this subscriber 1 or for his subscriber identity module, in the billing calculation server 8); and

adjusting an account associated with the communication type if the address matches the identifier (pg.1, ¶ [0011] A message representing the service-related or private nature of the current or most recently made call can be sent by the mobile radio terminal 3 as a short message SMS, MMS, etc., USSD or in another manner to an address of the mobile radio network 5,6, from where it is forwarded to a billing calculation server 8 of the mobile radio network to enable the monthly charges to be calculated).

Prange fails to disclose providing a mobile communications terminal (MCT) on a commercial vehicle capable of communicating with a central station via satellite,

Wolfe et al. teaches providing a mobile communications terminal (MCT) on a commercial vehicle capable of communicating with a central station via satellite (pg.3, ¶ [0020] discusses Satellite communication system 100 comprises a Network Management Facility (NMF) 104 otherwise known as a central facility or hub, a

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communication satellite 106, at least one wireless transceiver, or mobile communication terminal (MCT), located within, a vehicle 108, and at least one dispatch center, dispatch center 102).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to include MCT within vehicles as taught by Wolfe et al. in the system of Prange, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**4. Claims 8, 14-15, 17, 22-23 and 25 rejected under 35 U.S.C. 103(a) as being unpatentable over Prange (2005/0086138) in view of Wolfe et al. (PG PUB. 2003/0083913) further in view of Kelley (2002/0042715).**

**As per Claims 14-15 and 22-23** Prange discloses the apparatus of Claim 1. However, Prange fails to disclose wherein the address comprises a destination and source address.

Kelley discloses wherein the address comprises a destination and source address (Figure 3, Separation process depicts Destination Phone number or URI and Originating Phone number, TCP/IP address, username or other mobile device owner-identifying attribute).

Therefore, it would have been obvious to one of ordinary skill in the art to modify the separate invoicing of private and service-related conversations of Prange to include the



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destination and originating phone numbers as taught by Kelley in order to delineate responsibility for payment of billings due to use of communication devices (Abstract).

**As per Claims 8, 17 and 25** Prange discloses the apparatus of Claim 1.

However, Prange fails to disclose *wherein the data packet is not forwarded to the digital processing device if the address does not match the identifier*.

Kelley discloses wherein the data packet is not forwarded to the digital processing device if the address does not match the identifier (pg.2, ¶ [0031] discusses Keypad Separation; after completing a service transaction (e.g. a voice or data call or browsing to a URI), or before completing said transaction, which is based on the features and capabilities of the mobile device being used, the user enters one or more pre-designated keys (e.g. pressing `1` for personal or `2` for business). These additional keys are recorded by the carrier (=Service provider) and are included in the CDRS. During the separation process calls are identified as employer or employee calls by looking up the entered key and comparing it to what the employer had specified as codes indicating either business or personal transactions).

Therefore, it would have been obvious to one of ordinary skill in the art to modify the separate invoicing of private and service-related conversations of Prange to include the ability to filter calls that match stored identifiers as taught by Kelley in order to delineate responsibility for payment of billings due to use of communication devices (Abstract).

The Examiner notes the emphasized portion of the above claim recite a negative limitation, which define the invention in terms of what it was not, rather than pointing out the invention, therefore the emphasized portion will be given little patentable weight. Also for examination purposes, the Examiner will take the broadest reasonable interpretation of the above underlined portion of the claims. Since the "if" statement is conditional and not necessarily performed, once the positively recited steps in the claims are satisfied, the method as a whole is satisfied -- regardless of whether or not other steps are conditionally invocable under certain other hypothetical scenarios.

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1, 10 and 18 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tayloe (#5,987,325) discusses multiple smart card phone and method.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ASHFORD HAYLES whose telephone number is (571)270-5106. The examiner can normally be reached on Monday - Friday 8:00 A.M.- 5:00 P.M..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Gart can be reached on 571-272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elaine Gort/  
Primary Examiner, Art Unit 3687

/A. H./  
Examiner, Art Unit 3687